

### Remarks

The May 26, 2009 action was reviewed with care in preparation for this amendment and response.

Claims 77, 80-82, 84 and 86 were rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. More particularly, the Examiner asserted that the term “submersible” was not sufficiently described in the specification. This term has now been deleted from claims 77 and 92. Thus, the basis for this rejection has been eliminated.

Claims 77, 80-82, 84 and 86 were rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker and Nadel. Independent claims 77 and 92 have been amended to further clarify applicants’ invention as patentably distinct over the prior-art references. Applicants believe that claim 77 with its dependent claims 80-82 and 84 and claim 92 are now in condition for allowance.

Independent claims 77 and 92 have now been amended to emphasize the unique nature of the LED illuminator. More specifically, amended claims 77 and 92 now require that the switch be a *single-piece annular* switch which *entirely encircles a lens* for an LED-light passage therethrough (as seen at least in applicants’ original Figure 3 and described on page 6, lines 25-27, page 7, lines 1-3 and 5-7, and page 8, lines 18-20). Amended claims 77 and 92 further require that the switch be *rotatably water-tightly* secured to the light body for on/off switching of electric power to the LED and *watertight sealing of the single recess*.

In the inspection light of the Cooper et al. patent, as discussed in applicant’s September 3, 2008 response, the LED lamp extends out by itself similar to a tip of a pen such that this lamp has no “lens” to be entirely encircled by anything. Furthermore, the LED lamp of the Cooper et al. inspection light is in a lamp assembly which is separate and is releasable from the battery housing. The Cooper et al. inspection light does not have a single recess containing both the LED and the battery, as required by claims 77 and 92. Therefore, there is nothing to be water-tightly sealed in the manner required by amended claims 77 and 92. Any modification of such configuration would clearly be against the teachings of the Cooper et al. patent and would dramatically change the principle of operation of the Cooper et al. inspection light.

Each of the Baker lighted mirror and the Shiao magnetic retriever has its light casing (lamp holder in Shiao) extending far forward from the rest of the device and does not have a lens encircled by a switch. Moreover, such light casing containing a light bulb is separate from a battery compartment, thus ruling out a single recess containing both the bulb and the battery. Such structures are critical for the intended purpose and operation of these devices. Each of these references clearly teaches away from anything entirely encircling the lens as well as a water-tightly sealed single inner recess, as required by applicants amended claims 77 and 92.

The Nadel patent also falls short in disclosing a single-piece annular switch entirely encircling the lens and rotatably water-tightly secured to the light body. In fact, the Nadel patent discloses only a switch in the form of a bent wire operated by a button on a side of the housing or as a pivotable element also operable by the switch button.

As already discussed in previous applicants' responses, the Blaschke net is so different that the modification suggested by the Examiner would simply destroy the principal qualities of the Blaschke net. When considered in its entirety, the Blaschke patent clearly discloses a structure completely different from applicants' invention. The Blaschke patent clearly fails to disclose limitations that are lacking from other cited prior art references.

Applicant respectfully notes that the Supreme Court, in *KSR* (*see KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385), warned that in an obviousness analysis "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." (S.Ct. p 1742; USPQ2d p 1397) Here, the rejection uses a combination of many references both with improper hindsight and using the teaching of applicant's patent application itself and against teachings of the references themselves. Such rejections involve collecting a multiplicity of references from various technological fields to assert that it would have been obvious to one skilled in the art to modify each of the cited references to achieve applicants' invention. The Federal Circuit has stated: "When prior art references require selective combination ... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself... ." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Given

the teachings away described above, there can be no motivation for the Examiner's combination; in fact, such rejections would clearly involve the impermissible hindsight.

Furthermore, MPEP 2143.01, paragraph VI, titled "The Proposed Modification Cannot Change the Principle of Operation of a Reference," provides that:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) ... The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.

The above discussion points out that operations of each of the devices of the various cited references would be dramatically affected by the modifications proposed by the Examiner.

Finally, applicants respectfully disagree with the Examiner's statement regarding the Williams declaration submitted under 37 CFR 1.132. Applicants respectfully point out that paragraphs 19 and 24-26 of the Williams declaration address the issue of impropriety of combination of the Cooper et al., Blaschke and Baker. Even though the expert opinion is not expressed in a patent language, the expert Williams expressly recognized that these references may not be combined.

Applicants respectively submit that their independent claims 77 and 92, as amended, are patentably distinguishable over the prior art references, either alone or in combination with any of the other references. All claims dependent on claim 77, including claims 80-82 and 84, are also patentably distinct and are ready for allowance.

Dependent claim 78 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker, Nadel and further in view of Shiao. This rejection is respectfully traversed in view of the foregoing amendments of the parent independent claim 77 and the above discussion. Claim 78 is in condition for allowance.

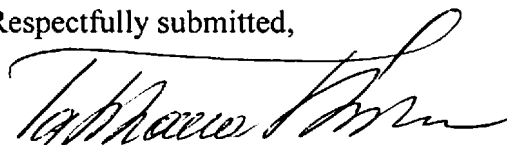
Dependent claim 79 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker, Nadel, Shiao and further in view of Lebens et al. This rejection is respectfully traversed in view of the foregoing amendments of the parent independent claim 77 and the above discussion. The Cooper et al., Blaschke, Baker, Nadel, Shiao and Lebens et al. patents, even in combination, fail to render obvious applicants' invention as set forth in claim 79. Claim 79 is in condition for allowance.

Dependent claim 83 was rejected under 35 USC 103(a) as unpatentable over Cooper et al. in view of Blaschke, Baker, Nadel and further in view of Brundage et al. This rejection is respectfully traversed in view of the present amendment of the independent claim 77, upon which this claim depends, and the above discussion. The Cooper et al., Blaschke, Baker, Shiao, Nadel and Brundage et al. patents, alone or in combination, fail to render obvious applicants' invention as set forth in claim 83.

In view of the above, allowance of this application is requested. The Examiner is invited to call the undersigned or attorney Peter. N. Jansson to resolve any issues that might remain.

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Respectfully submitted,



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